



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,829	10/26/2001	Steve B Burns	P 282646	1392

909 7590 02/20/2003

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 02/20/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,829

Applicant(s)

BURNS ET AL.

Examiner

Travis B Ribar

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-3, 5, 8, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claims 2-3 and 8, it is unclear from the language of the claim what the applicant intends to refer to by the phrase, "the reactant". The examiner is not sure of the definition of "the reactant" in claims 2 and 3, but believes that "the reactant" refers to component B in claim 8 and will examine the claim accordingly.
4. The examiner is not sure what range the applicant is claiming in claim 3, where the ratio of ethylene oxide to propylene oxide is at least 1 to 8. For the purposes of examination, this is presumed to mean that the most propylene oxide the adhesive can contain would be 8 times the amount of ethylene oxide.
5. Claim 5 recites the limitation "said polymeric polyisocyanate" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 1711

6. Claim 17 recites the limitation "a process for bonding" in line 1. There is insufficient antecedent basis for this limitation in the claim because the claim from which this claim depends, claim 16, is not a process claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Robertson et al. (WO 95/10555).

Robertson et al. discloses a moisture-activated adhesive composition that is made from either a blend of polymeric MDI and pure MDI or an isocyanate-terminated prepolymer (page 4, line 28 to page 5, line 2; page 6, lines 19-21; and page 5, lines 15-27) with an isocyanate-reactive compound that meets the applicant's specifications in claim 1 (page 8, lines 18-30). The polyol component contains ethylene-oxide in an amount that meets claim 2 (page 8, line 12) and also may contain amounts of propylene oxide meeting the restrictions of claim 3 (page 7, line 9). The adhesive in Robertson et al. also contains the amount of nitrogen in claim 4 (page 7, lines 24-30), the specific isocyanate in claim 5 (page 5, line 1), the prepolymer compositions of claims 6-7 (page 6, lines 4-18), the ethylene-oxide content limitations of claims 8-9 (page 8, lines 9-12),

Art Unit: 1711

the polyol limitations of claims 10-12 (page 7, lines 17-19; page 7, lines 31-33; page 8, lines 18-30), and the catalyst limitation of claim 13 (page 9, lines 21-29).

Robertson et al. also discloses the method the applicant claims in claim 14 (page 3, line 27 to page 4, line 5), along with the substrate properties of claim 15 (page 11, lines 10-12) and the product in claim 16 (page 10, line 24 to page 11, line 7).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Robertson et al. (EP 0723561) and Robertson et al. (US 6368714) disclose inventions similar to the reference used above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

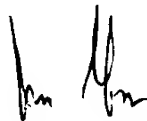
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1711

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar
Examiner
Art Unit 1711

TBR
February 4, 2003



James J. Snellett
Supervisory Patent Examiner
Technology Center 1700